REMARKS

Claims 1-9 and 16-17 are rejected under 35 U.S.C. §102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent claims 1 and 17 include:

Claim 1. A mobile computing system comprising:

a personal computer (PC) system;

a personal digital assistant (PDA) system that interfaces to the PC system;

a PC chassis;

a PDA chassis housing the PDA system, wherein the PC chassis houses the PC system and the PDA chassis, whereby the PDA chassis may be removed from the PC chassis, disconnecting an interface of the PDA system to the PC system, and providing an independent PDA system; and

the PDA chassis including:

a low power processor;

a memory;

a touch display screen;

a rechargeable battery;

connection bus hardware; and

a mini-dock connector to provide connection to the PC chassis.

Claim 17. A method of integrating a removable PDA system with a PC system comprising:

connecting the PDA system to the PC system by a separable interface;

isolating control to either PDA system or PC system when instructed by a user or a predetermined system logic; and

providing a PC chassis for housing a PDA chassis therein, the PDA chassis including:

a low power processor;

a memory;

a touch display screen;

a rechargeable battery;

connection bus hardware; and

a mini-dock connector to provide connection to the PC chassis.

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection the admitted prior art reference must contain all of the claimed elements of independent claims 1 and 17. However, the PDA chassis including: a low power processor; a memory; a touch display screen; a rechargeable battery; connection bus hardware; and a mini-dock connector to provide connection to the PC chassis, as claimed, are not shown or taught in the prior art references. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and17 and their respective dependent claims are not anticipated by the prior art references.

Claims 10-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of *Smith, II* (U.S. Patent 5,768,163).

Applicants traverse this rejection on the grounds that the references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

> ...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the references fail to teach the subject matter of claims 10-15 along with the PDA chassis including: a low power processor; a memory; a touch display screen; a rechargeable battery; connection bus hardware; and a mini-dock connector to provide connection to the PC chassis. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

> A patent may be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 1 and 17 have not been met by the cited references, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed.

Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d I 110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

> The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

> The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to the prior art as §103 requires. See, *e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Therefore, independent claims 1 and 17 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-17 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

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